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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,307	01/15/2002	Thomas E. Murphy JR.	END920010094US1	5180
23550	7590	07/13/2007	EXAMINER	
HOFFMAN WARNICK & D'ALESSANDRO, LLC			LIVERSEDGE, JENNIFER L	
75 STATE STREET			ART UNIT	PAPER NUMBER
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ALBANY, NY 12207				

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/047,307	MURPHY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jennifer Liversedge	3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 24 April 2007.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-26 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-26 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- Notice of References Cited (PTO-892)
- Notice of Draftsperson's Patent Drawing Review (PTO-948)
- Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- Notice of Informal Patent Application
- Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

This Office Action is responsive to Applicant's amendment and request for reconsideration of application 10/047,307 filed on April 24,2007.

The amendment contains original claims: 3-4, 6-9, 11, 13-16, 18-21 and 23-26.

The amendment contains amended claims: 1-2, 5, 10, 12, 17 and 22.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 recites the limitation "the using step". There is insufficient antecedent basis for this limitation in the claim.

Claims 3 recites the limitation "the receiving step". There is insufficient antecedent basis for this limitation in the claim.

Claims 3 recites the limitation "the transaction code". There is insufficient antecedent basis for this limitation in the claim.

Claims 4-5 and 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear based on a reading of the claims whether a message is retrieved from a message center as indicated in claims 4 and 11 or from a third party sender as indicated in claims 5 and 12. Examiner believes that

what is intended is that a message is retrieved from a third party sender via the message center. Appropriate correction is required.

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what is intended by the language of alerting a transactional clerk of the contact. It is unclear which contact is being referred to, who is doing the alerting, what responses is taken upon the alerting, etc. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 10-12 and 16-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Pub. No. US 2003/0195811 A1 to Hayes, Jr. et al. (further referred to as Hayes).

Regarding claim 1, Hayes discloses a method for receiving an alert code in a commercial transaction (Figures 1, 2B, 2C, 3B-7; pages 1-6), comprising the steps of:

Using a transactional device in a commercial transaction (Figures 1, 2B, 4C—5B, 6A-7; pages 1-6); and

Receiving an alert code attached to transaction data for the commercial transaction indicating receipt of a message from a third party sender (Figures 2B- 2C, 3B-7; pages 1-6).

Regarding claim 10-12, Hayes discloses a method, system and program product for receiving an alert code in a commercial transaction (Figures 1, 2B, 2C, 3B-7; pages 1-6), comprising the steps of:

Contacting a message center with a message from a third party sender (Figures 1, 2B, 2C, 3B-7; pages 1-6);

Using a transactional device in a commercial transaction (Figures 1, 2B, 4C—5B, 6A-7; pages 1-6);

Identifying an intended recipient of the message (Figures 1, 2A-2C, 3B-7; pages 1-6);

Attaching an alert code to transaction data for the transaction (Figures 2B-2C; pages 1-6);

Receiving the alert code attached to the transaction data, wherein the alert code is unrelated to the transaction (Figures 2B- 2C, 3B-7; pages 1-6); and

Retrieving the message in response to the received alert code (Figures 2B- 2C, 3B-7; pages 1-6).

Regarding claims 2-5, Hayes discloses contacting a message center with the message prior to the using step and receiving a transaction request after the using step; attaching an alert code to transaction data in response to the transaction request; sending the alert code attached to the transaction code; retrieving the message from the third party via the message center in response to the received alert code by contacting the message center and providing a unique identifier (Figures 1, 2B, 2C, 3B-7; pages 1-6).

Regarding claim 6, Hayes discloses where in the transactional device is selected from the group consisting of a magnetic device and a machine-readable code containing device (Figure 5B-5E).

Regarding claim 7, Hayes discloses wherein the alert code is unrelated to the commercial transaction (Figures 1, 2B, 2C, 3B-7; pages 1-6).

Regarding claim 16, Hayes discloses alerting a transaction clerk of the contact (page 6, paragraph 56).

Regarding claims 17, 19, 22 and 24, Hayes discloses a system and program product stored on a recordable medium for receiving an alert code in a commercial transaction (Figures 1, 2B, 2C, 3B-7; pages 1-6), comprising:

A message reception system for receiving a message from a third party sender (Figures 1, 2B, 2C, 3B-7; pages 1-6);

A recipient identification system for identifying an intended recipient of the message based upon use of a transactional device during a commercial transaction (Figures 1, 2A-2C, 3B-7; pages 1-6);

An attachment system for attaching an alert code to transaction data for the transaction (Figures 2B-2C; pages 1-6); and

A message transmission system for transmitting the received message (Figures 2B- 2C, 3B-7; pages 1-6).

Regarding claims 18 and 23, Hayes discloses wherein the message reception system records the message, and wherein the message transmission system plays the recorded message (Figures 5B-5E; page 4, paragraph 46).

Regarding claims 20 and 25, Hayes discloses wherein the alert code is unrelated to the transaction (Figures 2B- 2C, 3B-7; pages 1-6)

Regarding claims 21 and 26, Hayes discloses a subscription system and program product for the intended recipient to subscribe to a message service (page 2, paragraph 31; page 3, paragraph 32).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 8-9 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayes as applied to claim 1 above, and further in view of case law (*In re Kuhle*, 526 F.2d 553, 188 USPQ7 (CCPA 1975)).

Hayes does not disclose wherein the alert code is appended, prepended or embedded to or in a transaction code. However, it would be obvious to one of ordinary skill in the art to place the alert code in either of an appended, prepended or embedded location relative to the transaction code. For example, in the Kuhle case, the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice. Applicant has offered no specific reasoning as to why it is critical that the alert be placed in the appended, prepended or embedded location and Examiner holds that it is therefore obvious to place it in any relative location.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hayes as applied to claim 10 above, and further in view of Warmack.

Hayes does not disclose wherein the transactional device is a magnetic device. However, Warmack discloses wherein the transactional device is a magnetic device (pages 1-5). It would be obvious to one of ordinary skill in the art to modify the message system by transaction activation mechanism as disclosed by Hayes to adapt the use of credit cards as a transactional device as disclosed by Warmack. The motivation would be that frequently credit cards are included in PDAs, phones, etc. and as Warmack notifies when a credit card is used, Hayes knows when a system is on-line and can send notification as to that information. Accordingly, integrating the use of credit cards as disclosed by Warmack with the system as disclosed by Hayes would enable messages to be sent when a device and its components are in active mode.

#### ***Response to Arguments***

Applicant has argued that Hayes does not disclose receipt of a message from a third party sender. However, Hayes is a message center set up for the distribution of messages from third party senders as evidenced through the specification, where companies can create business-specific alert messages to send to users be it related to package delivery and tracking, flight status, check overdraft warnings, etc. These are all third party message senders.

Further, Applicant has argued that it is not obvious to place a message in either a prepended or appended location. In response, Examiner has offered case law

supporting the position that it is obvious and a matter of design choice as Applicant has not offered any specific reasoning as to the criticality of the placement.

***Conclusion***

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday – Friday, 8:30 – 5 PM.

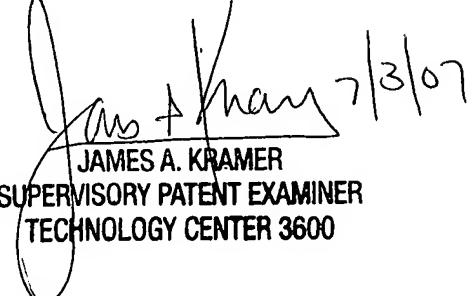
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jay Kramer can be reached at 571-272-6783. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Liversedge

Examiner

Art Unit 3692

  
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7/3/07